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EXAMINER

STORK, KYLE R

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,573

Applicant(s)

ZETTEL ET AL.

Examiner

Kyle R Stork

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2178

DETAILED ACTION

1. This office action is in response to the amendment filed 28 October 2004.
2. In the amendment, claim 30 has been cancelled. Claims 1-29 are pending. The rejection of claims 1-29 under 35 U.S.C. 103(a) as being unpatentable over the previous combinations of Alam et al. (US 6336124), Williams (US 5251314), Chen et al. (US 6009442), Rothfus et al. (US 6044372), Ouchi (US 6370567) has been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly added term "substantially" in claim 16 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 17-24 are rejected based upon their dependence upon a rejected base claim.

Art Unit: 2178

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Section 2106 of the MPEP states:

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se
Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

6. Claims 8-15 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 8-15 "a computer program" is disclosed. This is non-statutory under 35 U.S.C. 101 because such program does not define any structural and

Art Unit: 2178

functional interrelationships between it and other claimed aspects of the invention which permit the program's functionality to be realized as designated by the MPEP. Further, a computer program is not tangible and must be embodied on a computer readable medium, as opposed to being merely operable when executed by a computer.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 4-11, 13-15, 25, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Academic Technology Services (referred to as ATS) (Adobe PDF for Electronic Publishing, 1999).

As per independent claim 1, ATS discloses a method to electronically publish media comprising the steps of:

- Accessing an electronic data file (page 3, number 1)
- Receiving a publication instruction from a user to publishing the accessed data file (page 3, number 2)
- Initializing a publication enabler capable of converting a data file into at least one publication format, wherein the publication enabler is independent of a document creation application used to create the electronic file (pages 4-5, numbers 3-6)

Art Unit: 2178

- If necessary, converting the accessed data file directly into another publication format (pages 4-5, numbers 3-6)
- Publishing the data file in at least one publication format (page 5, number 7)

As per dependent claim 2, ATS discloses the method wherein the step of publishing further comprises at least one of the steps of displaying the file on a graphical user interface, transmitting the data file via an electronic messaging system to at least one remote user, and storing the data file in memory of a computer (page 5, number 7: Here, the PDF can be immediately displayed and stored).

As per dependent claim 4, ATS discloses the method wherein at least one of the publication format includes at least one of an RTF, HTML, PDF, TIFF, JPEG, GIF, BMP, and fax compression format (page 5, number 7).

As per dependent claim 5 ATS discloses the method further comprising the step of transmitting the data file to a document management system capable of assigning a coded filename, a storage location, and a file identifier to the data file (page 5, number 7: Here, the file is saved to the hard drive in a document management system under a filename).

As per dependent claim 6 ATS discloses the method further comprising the step of retrieving the data file from the DMS based on any of the file identifier, coded filename, storage location, an author, a title, a subject, a format, an approver, and a work flow recipient (page 13, Viewing a PDF file: Here, the data file is retrieved through the filename based upon a user selection).

Art Unit: 2178

As per dependent claim 7 ATS discloses the method further comprising the steps of initializing the publication enabler with an application capable of printing the electronic data file (page 3, Creating a PDF from an existing electronic document: Here, the PDF is published from a word processing document).

As per independent claim 8, the applicant discloses the computer program for executing the method of claim 1. Claim 8 is similarly rejected under ATS.

As per dependent claim 9 ATS discloses the computer program wherein the at least one publication format includes media formats foreign to the media creation application (page 3, Creating a PDF from an existing electronic document: Here, the original document is foreign to the final PDF application).

As per dependent claim 10 ATS discloses the computer program wherein the at least one publication format includes at least one of a portable document format, a hypertext markup language, an x-markup language, a rich text format, a JPEG format, a GIF format, a TIFF format, encryption formats, a bitmap format, compression format, or electronic messaging formats (page 5, number 7).

As per dependent claim 11, the applicant discloses the computer program for executing the method of claim 5. Claim 11 is similarly rejected under ATS.

As per dependent claim 13 ATS discloses the computer program wherein the media publisher is configured to be implemented with a plurality of media creation applications (page 3, Important Note: Here, the publishing can be implemented with files stored on either a Window or Macintosh machine, each machine containing different proprietary applications).

Art Unit: 2178

As per dependent claim 14, the applicant discloses the computer program for executing the method of claim 6. Claim 14 is similarly rejected under ATS.

As per dependent claim 15 ATS discloses the computer program wherein the set of instructions further causes the computer to electronically transmit the content via a communication interface including a telephone interface, an electronic message interface, and wireless interface (page 14: Distributing and Viewing PDF files on the Web: Here, the web is a communication interface).

As per independent claim 25, ATS discloses a system for publishing document to a document management system comprising:

- A computerized network (page 14: Distributing and Viewing PDF files on the Web: Here, the web is a computerized network)
- A readable memory electronically linked to a network (page 14: Distributing and Viewing PDF files on the Web: Here, the server is a memory electronically linked to a network)
- A plurality of computer connected to the network, wherein at least one of the plurality of computers, displays electronic data to a user in the form of a GUI (page 14: Distributing and Viewing PDF files on the Web; page 3)
- A processing unit programmed to call the GUI on demand and enable a user selection of one or more publication formats, wherein the one or more publication formats including publications formats non-native to a creation document (pages 4-5, numbers 3-6)

Art Unit: 2178

- The processing unit is further programmed to convert a document to at least one of the publication formats and call the GUI directly from the application used to create a document a user desires to publish (page 5, number 7)

As per dependent claim 27 ATS discloses a system wherein the processing unit is further programmed to assign a document title, document subject, and document author to the document (page 5, number 7: Here, the filename given to a document is assigned to the document by the processing unit).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS in further view of Williams (US 5251314, 1993).

As per dependent claim 3 ATS discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS fails to disclose routing the data file to at least one of an approving supervisor and a work flow recipient. However, Williams discloses transmitting data files to a work flow recipient (Figure 3, item 92; column 6, lines 49-52).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method of document publishing with

Art Unit: 2178

Williams method of document routing, since it would have allowed a user to publish a document and route it so that it may be used by a subsequent user (Williams: column 3, lines 50-54).

11. Claims 12 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over ATS in further view of Alam et al. (US 6336124).

As per dependent claim 12, ATS discloses the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS fails to specifically disclose the computer program wherein the set of instructions further causes the computer to receive more than one media control instruction and simultaneously transform the content of the electronic media into more than one format. Alam discloses the computer program wherein the set of instructions further causes the computer to receive more than one media control instruction and simultaneously transform the content of the electronic media into more than one format (Figure 6, items 626 and 534: Here, a PDF and an Output Format Document are both generated based upon one command).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's program for publication with Alam's program for generating multiple document formats, since it would have allowed a user to generate multiple documents for several applications.

As per independent claim 16, ATS discloses the computer readable storage medium having a computer program stored thereon and embodying a sequence of instructions that when executed by a processor causes the processor to:

Art Unit: 2178

- (A) access an electronic file (page 3, number 1)
- (B) display a GUI configured to facilitate a user selection of a number of publications commands (pages 4-5, numbers 1-6)
- (C) receive a user selection of at least one publication command (page 3, number 2)
- (E) transmit the converted data to at least one publication system capable of publishing the data file into a publication format (page 5, number 7)

ATS fails to specifically disclose:

- (D) route the electronic data file to a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats
- (E) two converted data files

Alam discloses:

- (D) route the electronic data file to a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats (Figure 6: Here, a PDF and an Output Format Document are publication formats.)
- (E) two converted data files (Figure 6)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's medium for publishing with Alam's medium for using multiple data files, since it would have allowed a user to save time by creating more than one file with a single publication command.

Art Unit: 2178

As per dependent claim 17 ATS and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to display the GUI in response to a document management instruction (page 3, Figure 1).

As per dependent claim 18 ATS and Alam disclose the limitations similar to those in claim 17, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to execute acts (A) through (E) in response to a user print instruction (Figure 1).

As per dependent claim 19 ATS and Alam disclose the limitations similar to those in claim 18, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to recognize a user print instruction from any software application capable of printing the electronic data file (page 3, Creating a PDF from an existing electronic document).

As per dependent claim 20 ATS and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam further discloses the print driver wherein the number of publication commands include a publish command including a convert to a PDF command and a convert to HTML command (column 2, lines 28-36).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Alam's medium for publication with Alam's method of converting to PDF and HTML, since it would have allowed a user to convert data into more than out format.

Art Unit: 2178

As per dependent claim 21, ATS and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the number of publication formats include PDF, JPEG, GIF, TIFF, HTML, XML, RTF, TXT, DOC, encryption, PPT, and ZIP (page 5, number 7).

As per dependent claim 22, ATS and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to retrieve an electronic data file from a document management system capable of storing the electronic data file (page 3, number 1: Here, opening the document in the original format is retrieving a stored document).

As per dependent claim 23 ATS and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam discloses routing the converted data file to a supervisor and a subsequent document designate (column 2, lines 37-40).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Alam's medium for publication with Alam's method for transmitting the document, since it would have allowed a user to submit data to another.

12. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS and Alam further in view of Ouchi (U.S. 6,370,567).

Art Unit: 2178

As per dependent claim 24 ATS and Alam disclose limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS and Alam fail to specifically disclose displaying a listing of document approving supervisors. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12; column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the medium of ATS and Alam with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.

13. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS further in view of Chen et al. (U.S. 6,009,442).

As per dependent claim 26 ATS discloses the limitations similar to those in claim 25 and the same rejection is incorporated herein. ATS fails to disclose a system wherein the processing unit is further programmed to automatically generate a document identifier and assign the document identifier to the document. However, Chen discloses a system wherein the processing unit is further programmed to automatically generate a document identifier and assign the document identifier to the document (column 4, lines 9-11; column 4, lines 22-27).

Art Unit: 2178

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the ATS system with Chen's system of assigning a document identifier to a document upon document generation, since it would have allowed a user to save a document with a default set of document attributes that are set upon document creation.

14. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS in view of Ouchi.

As per dependent claim 28 ATS discloses limitations similar to those in claim 25, and the same rejection is incorporated herein. ATS fails to specifically disclose displaying a listing of document approving supervisors. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12; column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the system of ATS with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.

Art Unit: 2178

15. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS and Ouchi further in view of Williams.

As per dependent claim 29 ATS and Ouchi disclose limitations similar to those in claim 28, and the same rejection is incorporated herein. ATS and Ouchi fail to disclose routing the data file to at least one of an approving supervisor and a work flow recipient. However, Williams discloses transmitting data files to a work flow recipient (Figure 3, item 92; column 6, lines 49-52).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Ouchi's system of document publishing with Williams method of document routing, since it would have allowed a user to publish a document and route it so that it may be used by a subsequent user (Williams: column 3, lines 50-54).

Response to Arguments

16. Applicant's arguments with respect to claim 1-29 have been considered but are moot in view of the new ground(s) of rejection.

As detailed above, the ATS reference has been incorporated into the rejection in order to address the claimed feature amendments.

17. Applicant's arguments of the rejection of claims 8-15 under 35 U.S.C. 101 and 16-24 under 35 U.S.C. 103(a) filed 28 October 2004 have been fully considered but they are not persuasive.

Art Unit: 2178

As per claims 8-15, the applicant argues that "claim 8 calls for the computer to cause the functional changes called for in the claim." However, the program of claim 8 is not specifically embodied upon the computer or another computer readable medium. Consequently, independent claim 8 and the dependent claims 9-15 fail to meet the qualifications of statutory subject matter as set out by the MPEP Section 2106(a), and the rejection is subsequently upheld.

As per claims 16-24, the applicant argues that, "neither Alam et al. nor Williams teach or suggest any 'converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats.'" However, included in the drawings submitted by the applicant, Figure 7 discloses the equivalent of an intermediate document format (item 152, a PDF document). This document is equivalent to the intermediate document (Figure 5, item 530) disclosed by Alam et al. The examiner disagrees with the applicant's arguments, and maintains that Alam et al. discloses substantially simultaneous conversion of electronic data.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2178

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork
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